



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|--------------------|-------------|-----------------------|---------------------|
| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|--------------------|-------------|-----------------------|---------------------|

| |
|----------|
| EXAMINER |
|----------|

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 7/22/96
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or ~~thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1, 26-29 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 26-29 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. Claims 1 and 26-29 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claim 1 is rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Oppermann et al. (U.S. Patent No. 5,266,683, hereafter '683). The '683 patent, having priority dates back to 4-8-88 discloses and claims the claimed protein (see the claims, for example, especially claim 24 and SEQ ID NOS: 28 and 29 which refer to hOP2 beginning with Ala which anticipates the instant claims directed to positions 4-142 of SEQ ID NO: 14). This sequence also includes each of the species a) through c) of claim 1.

4. Claims 26-29 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Oppermann et al. (U.S. Patent No. 5,354,557, hereafter '557). Similarly to the '683 patent the '557 priority goes back to 4-8-88 and discloses and claim pharmaceutical compositions of the claimed proteins as set forth in the instant claims (see the whole patent, especially claims 48-55). With regard to claim 29, while the '557 patent does not specifically refer to a wound healing effective amount such would have been inherent since the use of the protein was

Serial Number: 08/319,831
Art Unit: 1814

-3-

for healing and rejoining bones and/or cartilage which is considered a wound or part of a wound.

Applicants argue that the priority date for the disclosure of hOP2 in 5,266,683 and 5,354,557 does not date back to 4/8/88, but that hOP2 is disclosed for the first time in Serial number 07/599,543 which has a filing date of 10/18/90 which has a later filing date than the instant application of 5/16/90.

Examiner notes that it cannot be known until all of these applications have been inspected in order to assign a priority date for the disclosure of hOP2. Of the ones that have been examined, it is clear that 08/599,543 does disclose hOP2. However, two others, 07/483,913 (filing date 2/22/90) and 07/600,024 (filing date 10/18/90) do not disclose hOP2. 07/600,024 discloses hOP1, but not hOP2. It appears that a few more cases ought to be reviewed near the filing date of the instant application in order to form a better picture of the priority date assignments for hOP2.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


Serial Number: 08/319,831
Art Unit: 1814

-4-

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyosuk Kim whose telephone number is (703) 308-4203.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Hyosuk Kim, Ph. D.


CHHAYA D. SAYALA
PRIMARY EXAMINER
GROUP 1800